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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,471	01/28/2004	Hirokazu Sawada	Q78015	9438

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,471

Applicant(s)

SAWADA ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed August 8, 2005 has been entered and fully considered.
2. Claims 1-21 are present, of which claim 21 is new. Claim 21 is supported by Example 1.
3. The claims are "product-by-process" claims or dependent on product-by-process claims. Applicant is reminded of MPEP 2113: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Terminal Disclaimer

4. The terminal disclaimer filed on August 8, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,808,864 B2, U.S. Patent No. 6,808,864 B2, U.S. Patent No. 6,194,082 B1, and U.S. Patent No. 5,507,887 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3, 5, 7-8, 10-11 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/855,868 (US 2005/0013724 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to make an aluminum alloy sheet for a lithographic printing plate comprising 0.2-0.6% Fe, 0.03-0.15% Si, 0.02 % Cu and 0.003-0.05% Ti based on claim 1 of Ougi et al.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1, 3, 5, 7-8, 10, 11, 12, 14, 15 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/784,879 (US 2004/0166442 A1). Although the conflicting claims are not identical, they are not patentably distinct from

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each other because it would have been obvious to one of ordinary skill in the art to make an aluminum support for a lithographic printing plate obtained by performing graining treatment wherein the support comprises 0.20-0.29% Fe, 0.03-0.15% Si, 0.020-0.040% Cu and 0.050% or less Ti based on the claims of Sawada et al.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 1, 3, 5, 7-8, 10, 11, 12, 14-15 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/059,378 (US 2002/0155377 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to make a presensitized plate comprising an aluminum support and a photosensitive layer formed thereon wherein the aluminum plate comprises 0.15-0.5% Fe, 0.03-0.15% Si, 0.003-0.50% Ti and 0.001-0.05% Cu and/or 0.001-0.1% Mg based on the claims of Sawada et al.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*The copending published patent applications and patents claim various characteristics presently claimed however, it is the Examiner's position the aluminum alloy supports of the cited published applications and patents inherently have the same characteristics because of the supports contain the same elements in at least overlapping amounts.

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Applicant is reminded of MPEP 2112 and 2112.01: "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-16, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishikawa et al. (EP 211 574).

a. The aluminum alloy support for lithographic printing plates of Nishikawa et al. anticipates the presently claimed aluminum alloy support. The aluminum alloy support of Nishikawa et al. is produced by cold rolling an aluminum alloy has a

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thickness of 0.1 to 0.5 mm and is composed substantially of 0.05 to 3% Mg, 0.05 to 0.7% Si, 0.01 to 0.25% Zr, 0.05 to 0.4% Fe (abstract; claims; column 4, lines 39-58) with Cu Zn and Ti as unavoidable impurities in an amount up to about 0.05% (column 3, line 30 – column 4, line 36). The support, when provided with a photosensitive layer (column 6, lines 9-13), anticipates the presently claimed presensitized plate.*

11. Claims 1-11, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (JP 2002-129270).

a. The aluminum alloy support for lithographic printing plate of Suzuki et al. anticipates the presently claimed aluminum alloy support has a crystal grain structure on the surface, a thickness of 0.1 to 0.5mm, tensile strength of 145 to 190 MPa and comprises 0.10 to 0.40% Fe, 0.03 to 0.15% Si, 0.004 to 0.020% Cu, 0.01 to 0.05% Ti, 0.002 to 0.02% Mg, 0.001 to 0.030% Zr and 0.0001 to 0.02% B (abstract; claims; [0021]; [0024]-[0030]).**

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hotta et al. (EP 1 013 469 A1) in view of Suzuki et al. (JP 2002-129270).

a. Hotta et al. teach a process for the preparation of a photosensitive lithographic printing plate. A positive working composition is coated on a support [0059], exposed to light and then subjected to development [0096] which is preferably an alkaline aqueous solution containing at least one saccharide [0097]-[0110]. The support is an aluminum plate can be made of pure aluminum or aluminum alloy comprising aluminum as a main component and a slight amount of foreign elements such as silicon, iron, copper and titanium [0009]. These foreign elements are present in an amount of not greater than 10%, however Hotta et al. do not specifically disclose how much of each foreign element is preferable. Based on the teachings of Suzuki et al., it would have been obvious to use an aluminum alloy support comprising 0.10 to 0.40% Fe, 0.03 to 0.15% Si, 0.004 to 0.020% Cu, 0.01 to 0.05% Ti, 0.002 to 0.02% Mg, 0.001 to 0.030% Zr and 0.0001 to 0.02% B (abstract; claims; [0021]; [0024]-[0030]) with reasonable expectation of obtaining good print durability based on the teachings of Suzuki et al. [0014]-[0015].**

**The cited references teach various characteristics presently claimed however, it is the Examiner's position the aluminum alloy supports of the cited references inherently have the same characteristics because of the supports contain the same elements in at least overlapping amounts. Applicant is reminded of MPEP 2112 and 2112.01: "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Where the claimed and prior art

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products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Response to Arguments

14. Applicant's arguments filed August 8, 2005 have been fully considered but they are not persuasive.

a. Applicant traversed the obviousness-type double patenting rejection over application No. 10/855868 and argued the rejection is improper because the copending application is assigned to Sumitomo Light Metal Industries and referenced an Assignment record. The Examiner disagrees. According to the entire Assignment record, said application was assigned to Sumitomo Light Metal Industries, Ltd. and Fuji Photo Film Co., Ltd. On August 19, 2005. See reel/frame 016424/0154.

b. Applicant argued the present application is not anticipated by EP'574 because said reference does not provide a specific example that is within the scope of the present invention. The Examiner acknowledges the lack of specific examples however maintains the claims are anticipated by EP'574 because the aluminum alloy substrate of said reference is taught with sufficient specificity and comprises the same metals in amounts that are within or overlap with the claimed ranges. MPEP 2131.03 II.

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Applicant further argued unexpected results however Applicant is reminded that evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973). MPEP 2131.04.

c. With respect to the rejection over Suzuki et al. (JP 2002-129270) and Hotta et al. (EP 1 012 469 A1) in view of Suzuki et al. (JP 2002-129270), Applicant pointed out that the presently required range of Cu is not taught in said reference. The Examiner disagrees. Suzuki clearly teaches an aluminum alloy support comprising 0.004 to 0.020% Cu which overlaps with the required Cu range of 0.02-0.05 wt %. MPEP 2131.03 II.

d.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
October 28, 2005